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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,766	03/15/2004	Edward G. Sutt JR.	032228-40100	8637
22204	7590	09/19/2007		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER BUI, LUAN KIM	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/799,766	Applicant(s) SUTT, EDWARD G.	
	Examiner Luan K. Bui	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-20, 28 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 21-27, 30, 31 and 33 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 12, 21-27, 30, 31 and 33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lat et al. (6,086,305; hereinafter Lat'305) in view of Rogers (6,584,915) and White et al. (6,422,447; hereinafter White'447). Lat'305 discloses a nail (20) manufactured from steel/steel wire suitable for pallet wooden board securement comprising a substantially round head (22) with a head diameter having a flat top surface and a bottom surface and a single elongate shank (24, 25, 28) integral with the head and extending from the head bottom surface. The shank further including a point (26) opposite the head and a substantially round cross section having a shank diameter between 0.075-0.15 inches and each nail has a length between 1.25-3.5 inches. Lat'305 also discloses the other claimed limitations except for a plurality of surface deformations being formed on the shank, the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37 and an attachment structure being constructed and arranged to temporarily attach a plurality of nails into a package. Rogers shows a plurality of nails (24) formed from wire comprising a substantially round head (28, Figures 2 and 3) having a head diameter, a single elongate shank (26) integral with the head and extending from a head bottom surface, the elongate shank further including a point (30) opposite the head and a plurality of surface deformations (32, 34). Rogers further shows the shank having a shank diameter of about 3.1mm (0.12 inch). White'447 suggests a plurality of

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nails having a shank diameter of about 0.12 inch +/- 0.0015 inch, a head diameter of about 0.350-0.438 inch and an attachment structure (36) constructed to temporarily attach the plurality of nails into a package. White'447 suggests the ratio of the head diameter (0.350 inch) to shank diameter (0.12 inch) of each nail is about 2.92 which is between 2.70 and 3.37 as claimed.

It would have been obvious to one having ordinary skill in the art at time the invention was made in view of Rogers and White'447 to modify the plurality of nails of Lat'305 so the shank of each nail comprises a plurality of surface deformations as taught by Rogers to prevent the nails from withdrawal and getting loose from the pallet wooden board and each nail is manufactured with the head diameter of about 0.35 inch and also includes an attachment structure constructed and arranged to temporarily attach the plurality of nails into a package as taught by White'447 for better securing the nails into the pallet wooden board and to keep the nails together as the package. The attachment structure for temporarily attaching the plurality of nails into the package is old and convention since Lat'305 discloses that the nail is adapted to be used in a power driving tool (see abstract). The nail of Lat'305 as modified comprises the ratio of the head diameter (for example 0.12 inch, see Lat'305 above) shank diameter (0.35 inch) is between 2.70 and 3.37 as claimed.

Allowable Subject Matter

3. Claim 11 is allowed.

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4. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on 7/31/2007 have been fully considered but they are not deemed to be persuasive.

Applicant argues that the references of record clearly teach away from modifications of nails is noted. This is not persuasive because Lat discloses that various modifications and improvement can be made without departing from the spirit and scope of the invention (column 5, lines 49-58). Since Lat is silent about the head diameter of each nail, there does not appear to be anything unobvious about using the teaching of White to modify each nail of Lat so it comprises the head diameter as taught by White because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Applicant's arguments with respect to ASTM F1667 in the remarks are noted. They are not persuasive because ASTM F1667 is not used in the Office Action.

Applicant's arguments with respect to the commercial success and the Declaration as to commercial success filed by Edward Sutt have been reviewed and are not persuasive since the

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applicant fails to establish a nexus between the claimed invention and the commercial success because there is no evidence that the product has been sold corresponds to the claimed invention. see MPEP 716.03. Furthermore, with respect to the smaller shank diameter (0.084 inch) than the conventional pallet nails, Lat discloses the pallet nails can be provided with smaller shank diameter without sacrificing other desirable properties ... because smaller diameter pallet nails are less likely to split the wooden substrate and are easier to fully drive into the substrate (column 4, line 62 to column 5, line 5).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb
September 10, 2007

/Luan K. Bui/
Primary Examiner
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